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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,781	08/27/2001	Theresa L. McGuire	10992766-1	6757

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/940,781

Applicant(s)

MCGUIRE ET AL.

Examiner

Jerome Grant II

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6-13-05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/01/03 4/03

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

**A person shall be entitled to a patent unless -**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

Claims 1-5, 7, 10, 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,421,135 B1 to Fresk et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding Claim 1, Fresk et al. disclose a method for scanning a job on a document-processing device when a print path is not available (Column 13 Lines 5661), the device having a printer job channel (the Print Processor disclosed by Fresk et al., Element 23 of Figure 6, is equivalent to the claimed printer job channel because, according to the instant application, the printer job channel is a component that provides access to the print path and the print engine. Refer to the Specifications, Page 9 Line 10), the method comprises:

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upon initiating a job, determining that a printer job channel is not available (refer to Column 13 Lines 56-61);

scanning the job (refer to Column 13 Line 59);

spooling the job to a mass storage device (refer to Column 13 Line 60); and storing the job in the mass storage device until the printer job channel becomes available (refer to Column 13 Lines 60-61).

Regarding Claim 2, wherein initiating a job includes user input on a control panel on the device (Fresk et al. disclose that a user can start a job via the user interface. Refer to Column 5 Lines 25-27, and Column 8 Lines 64-65).

Regarding Claim 3, wherein initiating a job includes triggering a media sensor on the device (Fresk et al. disclose that a sensor can be used to start a job via the user interface. Refer to Column 5 Lines 25-27, and Column 10 Lines 62-67 and Column 11 Lines 1-5).

With respect to claim 4, Fresk teaches a method of scanning a job (copy job 96 according to the 3<sup>rd</sup> paragraph of col. 10), on a document processing device when a print path is not available, (interruption of the printer as taught at col. 10, line 32 and 33), the device having a printer job channel, the method comprising: determining that a printer job channel is not available (copy processor 92, see col. 10, para. 3; requesting user input selecting whether to proceed with the job (walk up user is submitting the job thus interrupting

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the printer, see col. 10, lines 47-50); and upon receiving user input electing to proceed, scanning the job, spooling the job to a mass storage device, and storing the job in the mass storage device until the printer job channel becomes available (see col. 13, lines 55-67).

Regarding Claim 5, wherein spooling the job to a mass storage device includes storing the job as a data file (Fresk et al. disclose that the entire document is stored to disk. Refer to Column 13 Lines 59-60).

Regarding Claim 7, wherein the mass storage device is a non-volatile memory (Fresk et al. disclose that a disk is used to store image data. Hard disk drives are inherently known as non-volatile memory devices. Refer to Column 13 Line 60).

With respect to claim 9, Fresk teaches a copy job going through a print engine 20 to through the print channel (which is the channel between the print engine controller 19 and the print engine 20).

Regarding Claim 10, Fresk et al. disclose a document-processing device (see Figure 1 Element 100) which is configured to concurrently scan a first job and print a second job (refer to Column 13 Lines 58-61), the device comprising:

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a copy module configured to scan a first job to produce scanned images of the first job (refer to Column 13 Lines 58-61, and also see Figure 1 Element 60),  
a mass storage device coupled with the copy module (see Figure 3 Element 10. Mass storage device is connected to Element 50, and Element 50 is connected to the copy module as illustrated in Figure 2); and a printer module (19 and 20 combined) coupled with a copy module 60, the printer module having a controller 19 configured to temporarily direct the scanned images to the mass storage device (disk according to col. 13, line 60) configured to temporarily direct the scanned images to the mass storage device when the printer module is otherwise engaged (see col. 13, lines 55-67 where the controller 19 prevents data from port 51 to come there but sends it to bus 17 to be stored in the disk 10 of figure 3.

With respect to claim 12, Fresk teaches the mass storage device is integral with the copy module via bus 17 and I/O port 51. (See also figures 2 and 3).

Regarding Claim 13, the controller is configured to automatically retrieve the scanned images from the mass storage device when the printer module is not otherwise engaged (Fresk et al. disclose on Line 60 of Column 13 that the scanned document is spooled after the print job completes. Since the print controller is in charge of the entire image forming device, it is clear that the print controller automatically retrieves the scanned document).

Regarding Claim 15, the mass storage device is a storage disk (see Figure 3 Element 10).

Regarding Claim 16, this claim is essentially the same as Claim 1 above, but implemented as computer program codes embedded in a medium readable by a computer or an electronic device. Therefore it is rejected based upon the rejection of Claim 1 above. Further it is inherent that computer program codes must reside within the ROM or RAM section (serves as readable medium) of the system disclosed by Fresk et al. (see Figure 1 Element 100, Figure 3 Elements 11 and 15, and Figure 5 Elements 34 and 36) to implement or realize the functions or methods (determine if print path is available, save scanned images of print path is unavailable, print the scanned images when the print path is available) of their invention.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,026,256 to Fresk et al.

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Regarding Claims 6 and 14, Fresk teaches all of the subject matter upon which the claim depends, see the rejection to claim 1 above.

What Fresk does not specially state is that the mass storage device (disk) is a volatile memory.

However, to one of ordinary skill in the art, it would have been obvious to use a RAM or ROM in order to function as a mass storage unit for the reason it is clear from the disclosure that the storage device is a volatile memory (RAM, or ROM. Refer to Column 6 Lines 15-21). Also, it would have been obvious to one of ordinary skill in the art to make a mass storage memory out of large capacity RAM or ROMs .

With respect to claim 8, Fresk teaches all of the subject matter upon which the claim depends, see the rejection to claim 1 above.

What Fresk does not teach is a method of periodically checking the status of the printer job channel and printing the job if the channel is available.

However, this limitation is inherent in that the copy processor 92 must check to see when the scanner is used in order to interrupt the printing function. Although there is no disclosure for a periodic check. If a check for the use of a print job is done a plurality of times in a day that the apparatus is being utilized, it can be said that that processor 92 periodically checks or frequently checks to see if the channel is open or not.



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Regarding Claim 11, it is clear that the mass storage device is integral with the printer module (see Figure 3 Element 10).

3.

### **Examiner's Remarks**

Applicant's remarks have been considered and are persuasive to some extent but moot in the other extent in view of the new grounds of rejection.

Applicant argues, at the top of page 6, that Fresk does not disclose determining the printer job channel is available. The copy processor, according to col. 13, line 47 performs the determination step. Col. 13, lines 59-60 refers to storing the entire document on a disk until the printer is available.

The examiner concurs with the argument found in the second full paragraph of page 6.

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With respect to the second full paragraph of page 7, applicant argues that Fresk does not disclose determining the availability of the channel. However, this argument has been addressed previously. The copy processor determines whether the print job is complete. When it is complete then the channel will be open. See col. 13, lines 56-61.

In the second full paragraph of page 8, applicant argues, Fresk discloses an automated method of interrupting a network print job in favor of a walk up user's job. The examiner does not agree. Col. 13, lines 55-65 addresses the user performing the walk-up operation. .

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4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on \*571-272-7463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

JEROME GRANT II  
PRIMARY EXAMINER